

REMARKS/ARGUMENTS

Claims 1-14 and 16-20 are pending. Claim 7 has been canceled without prejudice and without disclaimer. Claims 1, 10, 12-14, and 16 have been amended. New claims 21 and 22 have been added. The specification has also been amended to correct minor informalities. No new matter has been introduced. Applicants believe the claims comply with 35 U.S.C. § 101 and § 112.

Independent claims 1, 10, and 12-14 have been amended to recite that the stencil for the job definition statement contains, in accordance with a user selection made via the user interface, a definition statement for invalidating a specific description written in the stencil. Independent claim 16 has been amended to recite that the information about data concerning the policy rule contains, in accordance with a user selection made via the user interface, a definition statement for invalidating a specific description written therein.

The Examiner alleges that the claimed invention including such features is unpatentable under 35 U.S.C. § 103(a) over Park et al. (US 2001/0039594 A1). The Examiner takes Official Notice that the Perl programming language contains conditional statements, which can be used to invalidate a specific description or portion of text. The Examiner reasons that since the template script defines the workflow markups (paragraph [0056], lines 6-7) used to create workflow forms into which a user enters workflow configuration information via a browser (paragraph [0052], lines 1-4), it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a definition statement for invalidating a specific description in the stencil by using the conditional statements provided by the Perl programming language in order to allow the user to have better control of text inserted into the job specification programmatically, since the Examiner takes Official Notice that it is well known that the Perl programming language contains conditional statements.

This rejection contains two components. First, the Examiner takes Official Notice to establish the fact that Perl programming language contains conditional statements. Second, the Examiner contends that it would have been obvious to provide in the stencil a definition statement for invalidating a specific description written in the stencil.

To establish obviousness, there has to be some suggestion or motivation in the prior art. In this case, the Examiner relies on Official Notice to show even that there is the capability of providing a definition statement for invalidating a specific description written in the stencil, based on the fact that Perl programming language contains conditional statements. Clearly, Park et al. does not include any suggestion or motivation to provide a definition statement for invalidating a specific description written in the stencil. Thus, it appears the rejection under 35 U.S.C. § 103(a) is predicated on an inherency argument.

An inherent feature may be relied upon to establish a rejection under 35 U.S.C. § 103(a), but only if such inherency would have been obvious to one of ordinary skill in the art. “That which may be inherent is not necessarily known.” *In re Spormann*, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966); *Rijckaert*, 28 U.S.P.Q. at 1957. “Obviousness cannot be predicated on what is unknown.” *Spormann*, 150, U.S.P.Q. at 452; *Rijckaert*, 28 U.S.P.Q. at 1957.

In the present application, the stencil for the job definition statement contains, in accordance with a user selection made via the user interface, a definition statement for invalidating a specific description written in the stencil. The feature enhances the user's ability to generate a job definition statement or a policy rule. Park et al. lists many ways of using the Perl code for defining rules in paragraph [0058]. Nothing in Park et al., however, suggests the claimed feature. Conditional statements can be used for different purposes. Conditional statements do not inherently suggest a definition statement for invalidating a specific description written in the stencil.

To sustain a rejection under 35 U.S.C. § 103(a) on the ground of inherency, the Examiner must show that such inherency would have been obvious to one of ordinary skill in the art. The Examiner has not made such a showing.

As the court stated, “the inherency of an advantage and its obviousness are entirely different questions.” *Spormann*, 150 U.S.P.Q. at 452 (emphasis added). Further, “a retrospective view of inherency is not a substitute for some teaching or suggestion” in the prior art. *In re Newell*, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989). In this case, the art contains no teaching or suggestion for the recited features. Accordingly, Applicants respectfully submit that the Examiner has failed to establish obviousness by inherency.

Appl. No. 10/649,307
Amdt. dated December 16, 2005
Reply to Office Action of October 27, 2005

PATENT

For at least the foregoing reasons, independent claims 1, 10, 12-14, and 16, and claims 2-6, 8, 9, 11, and 17-22 depending therefrom, are patentable over Park et al. and other cited references.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Chun-Pok Leung
Reg. No. 41,405

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
RL:rl
60643927 v1